

REMARKS

Claim 27 does not raise new issues and should be entered for examination

Applicant amended claim 27 in its response of 5 Dec. 2007. On p. 15 of that response, Applicant explained:

Applicant herein amends claim 27 to clarify that the claim limitations involve circuit-switched voice calls and packet-switched data calls. Claim 27 is further amended to incorporate all of the limitations of dependent 29, which is canceled by amendments herein. These changes comport with the foregoing arguments and clarify the claims' patentable distinctions over Hummelgren.

Further, the originally filed claims differentiated between packet-switched data calls and circuit-switched voice calls. See independent claim 1 and dependent claim 6, in the original claims for example. Still further, the now-withdrawn Final Office Action of 25 June 2007 fully examined claim 27 and its dependent claim 29, which were combined in Applicant's 5 Dec. 2007 response to form the current version of claim 27.

Thus, the limitations of the current claim 27 have been at issue since the outset of prosecution, whether in independent or dependent claim form, and the examiner has twice examined such limitations—in the 6/25/2007 Final Office Action, claims 27 and 29 were rejected as anticipated by Amin, and in the 10/5/2007 Final Office Action, claims 27 and 29 were rejected as anticipated by Hummelgren. Applicant respectfully submits that this prosecution record demonstrates that claim 27 does not “raise new issues” and that it is inappropriate for the Patent Office now to make that allegation as a basis for refusing entry of the amended claim 27.

Final rejection is not appropriate and should be withdrawn

On 1/31/2008, the undersigned attorney and Examiner Van Tran spoke by telephone regarding the Final Rejection of 10/5/2007 and the corresponding Advisory Action of 1/25/2008. In that phone call, the undersigned attorney pointed out that the 10/5/2007 Final Rejection made entirely new rejections not necessitated by Applicant's amendments or arguments, and finality

was therefore improper. The undersigned attorney also noted that claim 27 (as amended in Applicant's 12/5/07 reply) did not appear in any way to require further consideration and search by the examiner. Applicant's Interview Summary from that phone call was submitted on 1/31/2008, and it stated in part:

The undersigned attorney and Examiner Van Tran spoke by telephone today (31 Jan. 2008). The undersigned attorney argued that the current Final Rejection should be withdrawn, and that the amendments to claim 27 at issue in the Advisory Action of 25 Jan. 2008 should not have required further consideration and search. Examiner Van Tran stated that the Patent Office would rescind the current Final Office Action, and that a new Action would be issued. Examiner Van Tran explained that this decision relieved Applicant of the obligation to reply to the current Final Rejection.

(Emphasis added.)

True to his word, Examiner Van Tran withdrew the Final Rejection of 10/5/2007 as improper. Now, however, more than one year later, the examiner's next action has been made final. Worse still, the claims are rejected under entirely new grounds of rejection. In simple terms, Applicant does not understand the rationale behind withdrawing the previous final rejection as being premature because it did not give Applicant a chance to respond to new grounds of rejection, only to wait more than a year later to issue yet another final rejection on yet more new grounds of rejection.

More plainly, Applicant's after-final remarks sent in response to the Final Office Action (FOA) of 6/25/2007 were deemed persuasive and that FOA was withdrawn. The examiner then issued another FOA on 10/5/2007, which cited new art and new grounds of rejection not necessitated by any of Applicant's arguments or amendments. Applicant persuaded the examiner to withdraw that FOA, because Applicant had not had a chance to respond to the new grounds of rejection. It is therefore improper to now entirely drop the grounds of rejection made in the 10/5/2007 FOA and make new grounds of rejection in a new action that has been made final. Again, the examiner has made new rejections based on new art, not necessitated by any argument or amendment by Applicant, and has given Applicant no chance to respond on the

merits. Applicant therefore respectfully requests that the examiner withdraw the finality of the current rejections.

Lewis does not anticipate claims 1, 6, 8-10, 13, 15-17, 19, 20, 22, and 23

The examiner cites new art ("Lewis," U.S. Pub. 2002/0194331) in arguing that claims 1, 6, 8-10, 13, 15-17, 19, 20, 22, and 23 are anticipated. In making these rejections, the new FOA states that:

Regarding claims 1, 10, 13, 17, , [sic] Lewis discloses a method and system for incoming call notification, comprising: receiving an incoming voice call for a mobile station that is busy in a packet-switched data call (see abstract, figs. 1-2, mobile station 14, packet-switched [sic] 34, step 50-54, paragraphs [0020], [0031-0033]); sending an incoming call notification to the mobile station via signaling over an existing traffic channel allocated to the data call (see fig.2 [sic] step 60, paragraph [0034]); and reconfiguring the existing traffic channel to support the incoming voice call and delivering the incoming voice call to the mobile station via the reconfigured existing traffic channel (see fig.2, step 62-72, paragraphs [0035-0042]).

Key aspects of these assertions, which are critically relied upon to make the anticipation rejections, appear to be incorrect.

As a first critical error, Lewis does not appear to teach reconfiguring an existing traffic channel, such as claimed in independent claim 1. Lewis' Summary (paragraph [0010]) teaches that a principal aspect of Lewis is delivering incoming call notification to a mobile station that is fully engaged, such that the incoming call cannot be connected without the mobile station being disconnected from at least one of its current calls. Disconnecting an existing call in favor of connecting a new call associated with Lewis' incoming call notification cannot be understood to be the same or equivalent to the claimed reconfiguring of a mobile station's existing traffic channel (being used for a packet-switched data call), for use in delivering an incoming circuit-switched voice call.

The error in the anticipation rejection is made clearer by the examiner's reference to Steps 62-72 in Fig. 2 of Lewis as evidence that Lewis performs the claimed reconfiguration of a

mobile station's existing traffic channel. Instead, Step 70 of Fig. 2 in Lewis explicitly depicts dropping a mobile station's current calls if the user accepts the newly incoming call, and connecting the new call. The examiner also cites to paragraph [0034] in Lewis, to support the allegation that Lewis teaches the claimed reconfiguring of an existing traffic channel being used for a current packet-switched data call, for use in delivering an incoming circuit-switched voice call to a mobile station. However, paragraph [0034] only states that, in Lewis, a mobile station that is not fully engaged, may place an existing call on hold to receive a new call; otherwise, the mobile station is provided with an incoming call notification (which gives the user the option to drop an existing call).

Further, paragraph [0036] of Lewis makes clear that delivering the newly incoming call in Lewis requires dropping existing calls and connecting the new call. That description contradicts the examiner's assertion that Lewis teaches the claimed reconfiguration of an existing traffic channel. Still further, paragraphs [0052] and [0053] make clear that Lewis' mobile station can be fully engaged in either voice calls or (packet-data) calls. In the latter case, Lewis advises sending an incoming call notification using Session Initiation Protocol (SIP) or some other packet protocol. In a related explanation, paragraph [0064] of Lewis states that:

If the response to the incoming call acceptance of step 122 is an incoming call acceptance, serving MSC 18 drops one or more of the calls in which mobile station 14 is engaged so that the incoming call may be connected to mobile station 14. Thus, if mobile station 14 is engaged in an active data session, then serving MSC 18 may drop the data session. If mobile station 14 is engaged in voice calls, then serving MSC 18 may drop one or more of the call legs that mobile station 14 is using.

(Emphasis added.)

Thus, rather than teaching the limitation in claim 1 of "reconfiguring the existing traffic channel to support the incoming voice call and delivering the incoming voice call to the mobile station via the reconfigured existing traffic channel," Lewis appears to explicitly and unambiguously teach dropping an existing data call. Because a reference anticipates only if it

teaches (expressly or inherently) every limitation of a claim at issue, and because Lewis appears to teach dropping existing packet data connections rather than reconfiguring them for voice call delivery, Lewis fails as a matter of law to anticipate independent claim 1 or any of its dependents.

Regarding claim 8, depending from claim 1, the examiner states that Lewis teaches its limitation that "...wherein reconfiguring the existing traffic channel [from claim 1] for use delivering the incoming voice call to the mobile station comprises establishing a new service option connection at a network Base Station (BS), and requesting a network Mobile Switching Center (MSC) to establish a voice connection for the incoming voice call." In supporting this rejection, the examiner refers to Step 64 of Fig. 2 in Lewis, and to paragraphs [0036], [0037], and [0063]. Step 64 in Fig. 2 of Lewis is a simple inquiry as to whether a mobile station transmitted its user's selection regarding whether to accept a new incoming call. The illustrated step and the accompanying description in Lewis are unrelated to the explicitly claimed limitation of reconfiguring an existing (packet-data) traffic channel for voice call delivery, based on establishing a new service option connection at a network base station. Paragraphs [0036] and [0037] do no more than explain that a user can press "END" or some other button to drop a current call in favor of receiving a new incoming call, and that Lewis' mobile station may display instructional text in that regard. Paragraph [0063] states only that Lewis' mobile station preferably provides a new call indication to a user and correspondingly transmits the user's selection.

In short, the examiner's citations to Lewis appear unrelated to the claim limitations at issue, and Applicant can discern no teachings in Lewis that are related to the limitations of claim 8. In that regard, Applicant has reviewed Lewis in electronic form, and can find no mention of establishing service options at a base station, for the claimed purpose, nor for any other purpose. Applicant respectfully submits that Lewis fails as a matter of law to anticipate claim 8

for this further reason. Similar arguments apply to claim 15, which depends from independent claim 10, and apply to claim 22, which depends from independent claim 17.

Regarding independent claim 10, it includes the limitation of "sending a call notification message to the mobile station and, responsive to receiving a return acknowledgment from the mobile station, reconfiguring the service connection of the mobile station to deliver the incoming voice call using the existing traffic channel." As such, Applicant submits that the above arguments made with respect to claim 1 apply with at least equal force to claim 10, and that claim 10 and its dependent claims are not anticipated by Lewis.

Regarding claim 16, which depends indirectly from claim 10 through claim 15, it includes the explicit limitation that "sending a voice service call setup request message to a Mobile Switching Center (MSC) comprises generating default voice service parameters at the BS rather than receiving requested voice service parameters from the mobile station." This generation of default voice service parameters is an advantageous aspect to one embodiment of reconfiguring an existing (packet data) service connection for delivering a voice call of a mobile station's existing traffic channel, as in claim 10.

The rejection of claim 16 appears not to address the actual claim limitations at issue. Careful electronic searching of Lewis by Applicant has not revealed any teaching or suggestion that default voice service parameters can be generated at a base station, rather than receiving requested service parameters from a mobile station, as part of reconfiguring an existing packet data service connection for use in delivering a voice call. As such, Applicant submits that Lewis as a matter of law does not anticipate claim 16. Similar arguments apply to claim 23, which depends indirectly from independent claim 17 through claim 22.

Regarding independent claim 17, Applicant notes that it includes the limitation of a base station that is configured to "send a call notification message to the mobile station and, responsive to receiving a return acknowledgment from the mobile station, reconfigure the

service connection of the mobile station to deliver the incoming voice call using the existing traffic channel." As argued in support of independent claims 1 and 10, Applicant submits that Lewis fails to teach the claimed reconfiguration and thus does not anticipate claim 17. Likewise, claim 27, as amended in Applicant's Office Action reply of 5 Dec. 2007, is not anticipated by Lewis.

Closing

Respectfully, Applicant believes that the finality of the current rejection is improper. Applicant has been afforded no opportunity to develop the issues surrounding the new rejections based on Lewis, which is the very reason that the prior final rejections based on Hummelgren were withdrawn. Further, Applicant asks that the examiner reconsider all rejections based on Lewis, as it appears that Lewis does not provide the teachings relied upon for the anticipation rejections.

Respectfully submitted,

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